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Paper No. 11

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**COPY MAILED**

OCT 28 2003

**OFFICE OF PETITIONS**

In re Application of  
John D. Newbold, et al.  
Application No. 09/828,621  
Filed: April 6, 2001  
For: NOZZLE FOR PRECISION LIQUID  
DISPENSING AND METHOD OF MAKING

ON PETITION

This is a decision on the petition under 37 CFR 1.137(a), filed August 18, 2003, to revive the above-identified application.

The petition is **DISMISSED**.

Any further petition to revive must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Petition under 37 CFR 1.137." This is **not** a final agency action within the meaning of 5 U.S.C. § 704.

A grantable petition under 37 CFR 1.137(a) must be accompanied by: (1) the required reply, unless previously filed;<sup>1</sup> (2) the petition fee as set forth in 37 CFR 1.17(l); (3) a showing to the satisfaction of the Commissioner that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(a) was unavoidable; and (4) any terminal disclaimer (and fee as set forth in 37 CFR 1.20(d)) required pursuant to 37 CFR 1.137(c). The instant petition lacks item (3).

<sup>1</sup> In a nonprovisional application abandoned for failure to prosecute, the required reply may be met by the filing of a continuing application. In an application or patent, abandoned or lapsed for failure to pay the issue fee or any portion thereof, the required reply must be the payment of the issue fee or any outstanding balance thereof.

The showing of record is not sufficient to establish to the satisfaction of the Commissioner that the delay was unavoidable within the meaning of 35 U.S.C. § 133 and 37 CFR 1.137(a). See MPEP 711(c)(III)(C)(2) for a discussion of the requirements for a showing of unavoidable delay. Specifically, an application is “unavoidably” abandoned only where petitioner, or counsel for petitioner, takes all action necessary for a proper response to the outstanding Office action, but through the intervention of unforeseen circumstances, such as failure of mail, telegraph, telefacsimile, or the negligence of otherwise reliable employees, the response is not timely received in the Office. Ex parte Pratt, 1887 Dec. Comm'r Pat. 31 (Comm'r Pat. 1887).

Petitioner states that from the Office action mailed to him by the examiner that, “it was not clear to the inventor that a response was required. That letter included information regarding claims which were acceptable and claims which were not acceptable. As the inventor, I was prepared to accept that those claims that were unacceptable would be dropped. It was not clear that it was necessary to inform the patent office of this information.”

A delay resulting from the lack of knowledge or improper application of the patent statute, rules of practice or the MPEP does not constitute an “unavoidable” delay. See Haines v. Quigg, 673 F. Supp. 314, 317, 5 USPQ2d 1130, 1132 (N.D. Ind. 1987), Vincent v. Mossinghoff, 230 USPQ 621, 624 (D.D.C. 1985); Smith v. Diamond, 209 USPQ 1091 (D.D.C. 1981); Potter v. Dann, 201 USPQ 574 (D.D.C. 1978); Ex parte Murray, 1891 Dec. Comm'r Pat. 130, 131 (1891).

In the section marked “Period for Reply” of the Office action mailed to applicant, it states in pertinent part, “Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED.” In view thereof, petitioner was clearly informed that a reply to the Office action was due. Accordingly, petitioner’s lack of knowledge does not constitute unavoidable delay.

Petitioner should consider filing a petition stating that the delay was unintentional. Public Law 97-247, § 3, 96 Stat. 317 (1982), which revised patent and trademark fees, amended 35 U.S.C. § 41(a)(7) to provide for the revival of an “unintentionally” abandoned application without a showing that the delay in prosecution or in late payment of the issue fee was “unavoidable.” This amendment to 35 U.S.C. § 41(a)(7) has been implemented in 37 CFR 1.137(b). An “unintentional” petition under 37 CFR 1.137(b) must be accompanied by the \$665 petition fee. A copy of the unintentional petition form is enclosed herewith for petitioner’s use.

The filing of a petition under 37 CFR 1.137(b) cannot be intentionally delayed and therefore must be filed promptly. A person seeking revival due to unintentional delay cannot make a statement that the delay was unintentional unless the entire delay, including the date it was discovered that the application was abandoned until the filing of the petition to revive under 37 CFR 1.137(b), was unintentional. A statement that the delay was unintentional is not appropriate if petitioner intentionally delayed the filing of a petition for revival under 37 CFR 1.137(b).

The instant petition is not signed by both of the inventors. 37 CFR 1.33(b)(4) states:

Amendments and other papers, except for written assertions pursuant to § 1.27(c)(2)(ii) of this part, filed in the application must be signed by all of the applicants (§ 1.41(b)) for patent, unless there is an assignee of the entire interest and such assignee has taken action in the application in accordance with § 3.71 of this chapter.

In view thereof, petitioner should note that, upon the filing of a renewed petition under 37 CFR 1.137(a) or upon the filing of an unintentional petition under 37 CFR 1.137(b), the petition must be signed by both inventors.

Further correspondence with respect to this matter should be addressed as follows:

By Mail:                   U. S. Patent and Trademark Office  
                                 P. O. Box 1450  
                                 Alexandria, VA 22313-1450

By facsimile:           (703) 308-6916  
                                 Attn: Office of Petitions

By hand:                   Office of Petitions  
                                 2201 South Clark Place  
                                 Crystal Plaza 4, Suite 3C23  
                                 Arlington, VA 22202

Telephone inquiries concerning this decision should be directed to Marianne Morgan at (703) 306-3475.

  
Frances M. Hicks

Lead Petitions Examiner  
Office of Petitions  
Office of the Deputy Commissioner  
for Examination Policy

Enclosure:   Blank Unintentional Petition Form